

10/071,034

- 27 -

A0000417-01-CFP

REMARKS

Claims 1 to 30 are pending in the application.

Claims 3 to 12 are original.

Claims 13 to 30 are cancelled.

Claims 1 and 2 are currently amended.

Claims 1 to 12 would be all of the claims remaining in the application if the amendments are entered.

Discussion of Amendments

Claim 1 is amended to delete subject matter drawn to a non-elected invention. Claim 2 is amended to correct a typographical error. Claim 13 is cancelled for being redundant in view of the amendment to Claim 1 and for being drawn to a non-elected invention. Claim 15 is cancelled for being redundant in view of the amendment to Claim 1. Claims 14 and 16 to 29 inclusive are cancelled for being drawn to a non-elected invention.

Applicants reserve their right to reintroduce claims embracing deleted or cancelled subject matter in this application or any continuations, divisionals, or continuations-in-part thereof.

Claim Rejections - 35 U.S.C. § 112

Claim 2 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner pointed out that Applicants have an O (oxygen) radical attached to nitrogen in the formula set forth at lines 3 to 8 of Claim 2.

Applicants respectfully traverse the rejection on the grounds that the formula in Claim 2 is currently amended to delete the oxygen radical and insert instead the substituent group "R." This amendment corrects a typographical error and finds support on page 5, at lines 22 to 27, and in original Claim 2 on page 96, at lines 23 to 24.

10/071,034

- 28 -

A0000417-01-CFP

Claim Rejections - 35 U.S.C. §102

Claims 1, 3 to 12, 13, 15, and 30 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bocan (WO 97/16184). The Examiner alleges that Bocan teaches an active compound (i.e., [2,4,6-tris(1-methylethyl)phenyl]acetyl]-2,6-bis(1-methylethyl)phenyl ester) of Applicants invention method is an ACAT inhibitor and therefore useful in the treatment of hypercholesterolemia and atherosclerosis and that the administration of this compound would inherently treat a disease by the pathways claimed in Claims 1 and 30.

Applicants respectfully traverse this rejection on the grounds that Claims 13, 15, and 30 are cancelled, rendering the rejection of Claims 13, 15, and 30 moot, and that Bocan does not disclose all of the elements of the invention of amended Claim 1.

Claim 1, as currently amended to advance prosecution, embraces the method of treating rheumatoid arthritis described therein. Claims 3 to 12 depend from Claim 1, and thus also embrace aspects of the method of treating rheumatoid arthritis. For proper anticipation, all of the elements of the claimed invention must be disclosed within a single reference. Applicants believe that Bocan does not literally or inherently disclose the claimed invention method of treating rheumatoid arthritis. Accordingly, Applicants believe that Claims 1 and 3 to 12 are not anticipated by Bocan and are thus patentable under 35 U.S.C. § 102(b) in view of Bocan.

Conclusion

In view of the above amendment and remarks, Applicants believe that the rejection of Claim 2 under 35 U.S.C. § 112, second paragraph, and the rejection of Claims 1, 3 to 12, 13, 15, and 30 under 35 U.S.C. § 102(b), are overcome. Applicants request removal of the rejections and reconsideration and allowance of Claims 1 to 12.

The undersigned would welcome a telephone call from the Office to discuss matters that might be resolvable by such communication.

Jun-09-2004 10:38am From-

PATENT PFIZER ANN ARBOR MI

7346222928

T-424 P.030/030 F-709

10/071,034

- 29 -

A0000417-01-CFP

Respectfully submitted,

Date: June 9, 2004

Claude F. Purchase, Jr.

Claude F. Purchase, Jr.

Reg. No. 47,871

Pfizer Inc.

2800 Plymouth Road

Ann Arbor, MI 48105

Tel. (734) 622-1692

Fax (734) 622-1553